

Remarks

Claim 1 has been amended to indicate that the claimed combination is characterized in that when the two mating sections are coupled together to form a container, the container encloses, substantially entirely, the adhesive trapping medium, and that when the mating sections are spread apart, the trapping medium is exposed and may be placed in a use condition with a "use" length of any desired dimension, within a reasonable range. All of this is explained in the application as filed, and before discussing the rejection, applicant would like to point out the features of the claimed invention.

As is obvious, the claimed invention is directed to a cartridge for flying insects using an adhesive trapping medium or "glue web", as opposed to a "glue board".

Insect traps which use a glue board or a glue web, in order to remain effective, require that the glue medium be replaced from time to time. The glue medium is sticky and somewhat difficult to handle if it is exposed. If the medium has been used, and it is desired to replace the cartridge and glue medium, the glue medium typically has trapped dead flies and other dead insects on it. Thus, whether the cartridge is in the "new" or "used" condition, it is undesirable for the person replacing the cartridge to touch the adhesive medium.

Contrast the present invention with the rigid, open and fixed cartridge of the *Regan* reference, in which a full "use" length of the trapping web is always exposed, and

the cartridge must be removed from the unit by grasping a raised ledge with the fingers and lifting, as will be discussed further below.

Thus, the primary advantage of the present invention is that when the two cartridge sections are assembled together, they cooperate to enclose, substantially entirely, the adhesive trapping medium. As is clear from the specification, the leading edge of the adhesive trapping medium is connected to the spool in the first cartridge section 51, whereas the remainder of the spool of trapping medium is held in the second cartridge section 51A.

When it is desired to replace a cartridge, the user simply rotates the spool housed in one section until it is exhausted, and then uses the other housing section to act as a cover to enclose the spent adhesive medium. When the cartridge is new, the user simply uncouples the two cartridge sections and pulls them apart to the desired length and inserts the sections into the proper cavities in the trap, all without touching the adhesive web.

Thus, this provides a second advantage and it is that the claimed cartridge can accommodate "use" lengths of trapping medium to traps of different length because it does not make any difference whether the length of the trapping medium in the trap is, for example, six inches, eight inches or ten inches. The cartridge acts the same whether it is in any of the traps of different length.

Turning now to the sole reference cited in the application, namely the *Regan* patent, it discloses a cartridge of rigid framework and of fixed length. Although it is true with the trap of *Regan* that it is possible to handle the trap without touching the adhesive medium, it is difficult to do so in replacing the *Regan* trap or in removing it from the unit, as can be appreciated from the showing of FIGS. 3 and 4 and the disclosure in column 5, lines 7-10. A raised channel 74 is located on the bottom wall 72 and serves as a grip for the cartridge for installing, removal and handling.

Moreover, turning to the disclosure of FIG. 5, the cartridge of *Regan* has a fixed length since the take-up roller and the supply roller are always located a fixed distance from one another as determined by the receptacles 80.

Turning now to the rejection, the Examiner takes the position that the claims are unpatentable over *Regan*. The Examiner asserts that *Regan* shows all the elements recited with the exception that the cartridge of *Regan* is not in two pieces which can be mated together. Without citing any suggestion in *Regan*, the Examiner argues that it would have been obvious to make the one-piece cartridge of *Regan* into two pieces "since the function is the same". Office Action, page 3. This statement is, applicant respectfully submits, erroneous in fact and in law. The fact is that the claimed invention performs two new functions not disclosed or suggested by *Regan*: (1) two sections combine to form a container enclosing the adhesive medium and rendering it more convenient to handle, replace and ship; and (2) the two separable sections permit the same size cartridge to provide use sections of variable length for use in traps of different

size, if desired.

For the legal position, the Examiner relies on two decisions to support this argument. The first is *In re Nerwin v. Erlichman*, 168 U.S.P.Q. 177. Applicant respectfully submits that the Examiner has cited these cases based on a misapprehension of the law. There is no broad, universal "negative" rule of patentability that in all cases making an element previously shown as a single piece into two pieces negates patentability. In the *Nerwin* case cited by the Examiner, obviousness under Section 103 was not even an issue. The case involved an interference proceeding and all of the issues revolved around whether there was an interference in fact, and whether one of the parties has sufficient disclosure to "make" the interference count. The only relevant statement by the Board of Interferences in the *Nerwin* decision is the statement "The mere fact that a given structure is integral does not preclude its consisting of various elements." (*id.* 179). This does not support the Examiner's statement.

Similarly, the second case relied on by the Examiner, *In re Dulberg*, 348 U.S.P.Q. 129 (CCPA 1961), does not stand for the proposition as broadly stated by the Examiner. Rather, the issue in the *Dulberg* case was whether the claimed structure was anticipated by a prior art showing of a cap which was press fitted into a support was sufficient to meet the claim requirement that there was "no opening" extending longitudinally through a holder of the material being dispensed. Not only was the holding of *Dulberg* highly fact specific, but it clearly does not support the Examiner's broad statement in the negative. In fact, the law of unobviousness is that the claimed invention must be

considered as a whole, which is the mandate of 35 U.S.C. §103. See, *Jones v. Hardy*, 727 F.2d 1524, 1529, 222 U.S.P.Q. 1021, 1024 (Fed. Cir. 1984) ("though the differences between the claimed invention and the prior art may seem slight, it may also have been the key to advancement of the art"). Moreover, the references must also be considered as a whole and they must suggest the desirability, and thus the obviousness of the invention. *Lindemann Maschinen Fabrik GmbH v. American Hoist & Derrick Co.*, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984). Finally, the references must be viewed without the benefit of hindsight vision afforded by the claimed invention. *W.L. Glore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983). Viewing the claimed invention in its entirety, the structure and advantages are not taught or suggested by the cited art.

Turning now to *Regan*, in its entirety, it discloses a rigid cartridge having an adhesive trapping medium which is exposed before and during use, as shown in FIG. 5, and wherein it is cumbersome to remove the cartridge. There is no suggestion whatever in *Regan* that the cartridge can be made into two sections forming a container for the adhesive web when coupled together. Rather, such a position ignores the teachings of *Regan* in which the cartridge is shipped, stored, used and disposed of, all in the same configuration of frame or bed. There is no frame in the claimed structure. There is no suggestion nor is there any reason to make the rigid frame of *Regan* into two sections, and to do so would be precluded by the nature of *Regan* which requires a rigid frame for use.

Thus, the Examiner's statement that it would have been obvious to make the one-piece cartridge of *Regan* into two pieces is without a basis in fact since the two piece cartridge of the claimed invention performs at least two important functions not possible by the original *Regan* disclosure, and only brought to light in the instant application. Moreover, for the reasons indicated above, this position is erroneous in law. Finally, there is no suggestion whatever in *Regan*, nor any incentive nor any reason, to make his cartridge into two separate pieces, let alone having two sections which cooperate to provide a container. In fact, the claimed invention teaches a way from *Regan* which discloses, in column 5, line 7:

A raised socket or channel 74 is formed in the underside of bottom wall 72 as a stiffening element and to facilitate gripping the cartridge 16 during installation, removal and handling.

Clearly, by gripping the cartridge by means of the raised channel 74, there is a risk, if not a likelihood, of touching the adhesive medium at either end of the cartridge. In any case, the law requires that the prior art be considered "as a whole", and *Regan* clearly teaches that the cartridge be removed and handled in a condition wherein the trapping medium is exposed and an integral frame supports the medium.

In each of the remaining structure recitations of claims 13-17, the Examiner acknowledges that the claimed subject matter is not disclosed in the prior art *Regan*, yet the Examiner concludes, without any further factual support, that all else would have been "obvious" to one of ordinary skill in the art with no suggestion of the structure, incentive or result other than through applicant's disclosure. This is clearly an improper

legal basis for supporting a §103 rejection which requires at least a suggestion, if not explicit disclosure, of the claimed structure.

With reference to claim 17, the Examiner concludes without any supporting factual evidence that "to employ curved side walls" would have been obvious "since changes in shape are obvious". This clearly is not and cannot be the law. If that were the case, the Wright brothers never could have obtained a patent on the shape of the leading edge of an air foil – one of the most significant developments in history, and one which was patented. Again, the decision cited by the Examiner, *In re Dailey, et al.*, 147 U.S.P.Q. 47, does not support such a broad legal negative rule of patentability. The decision in the *Dailey* case was fact specific, and the holding was that there were insufficient recitations in the claim at issue to overcome the rejection. In fact, there is a very strong dissent by Judge Smith in the *Dailey* case noting that §103 demands that the 1952 Act requires that the invention be considered as a whole and that the issue of obviousness must be determined as of the time the invention was made, and without reference to applicant's disclosure. As Judge Smith noted:

Here as in many commercially significant inventions, the simplicity of the device is the very thing which had eluded the art. (149 U.S.P.Q. at 55).


The Examiner's repeated conclusions that everything not shown in the prior art would have been obvious to a person of ordinary skill, and without further citation of facts or references clearly underscores that none of the rejections of the present claims are based on sufficient fact.

In re Appln. of Lambert  
Serial No. 10/672,432 ( 09/26/03)  
Examiner Rowan Art Unit 3643  
Amendment A

Reconsideration and withdrawal of the rejection of the claims is respectfully requested.

Respectfully submitted,

Date: June 10, 2004

  
\_\_\_\_\_  
James J. Hill, Reg. No. 24,287  
EMRICH & DITHMAR LLC  
125 South Wacker Drive, Ste. 2080  
Chicago, Illinois 60606  
(312) 663-9800 - Phone  
(312) 663-9822 - Fax  
EmrichJJH@aol.com - E-Mail

H:\Word\JJH\Paraclipse\2C Flying Insect Trap - Divisional Case\Application\Amendment A.wpd